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PATENT APPLICATION
Attorney Docket No.: 13.001.CON

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:)
Jeff Abel)
Serial No.: 10/616,460)
Filed: 7/08/2003) Art Unit
For: FISH NET WITH LENGTH) 3643
MEASURING SCALE)
Examiner: David Parsley)

BRIEF OF APPELLANT

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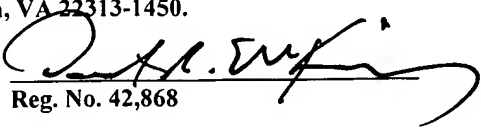
On September 11, 2006 Appellant filed a timely Notice of Appeal from the action of the Examiner, mailed June 22, 2006, finally rejecting all of the claims in this application. This brief is being filed under the provisions of 37 CFR 1.192. A check in the amount of \$315.00 is enclosed to cover the fee for filing an appeal brief under 37 CFR 41.20(b)(2), plus the fee for filing a terminal disclaimer under 37 CFR 1.20(d), at the small entity level.

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REAL PARTY IN INTEREST

The real party in interest is the inventor, Jeff Abel, captioned above.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1, 2, 4-14, 16-18, and 20-24 are pending and appealed in the present application. Claims 3, 15 and 19 have been canceled.

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the Final Office Action mailed June 22, 2006.

SUMMARY OF INVENTION

The present invention relates to an improved sport fishing net device used for landing a fish. The improved sport fishing net device includes a length measuring scale incorporated into the net bag, such that a user may visually determine the length of a fish contained in the net bag without having to handle the fish.

With reference to FIG. 1, reproduced below, in one embodiment the fish net device 10 includes a frame 12, and a net 14 attached to the frame. In the embodiment shown in FIG. 1, the frame includes a handle 16, and a substantially closed loop portion 18 attached to the handle, the net 14 being attached to and hanging from the closed loop portion 18. Disposed in a generally

linear configuration along a surface of the net 14 is a length measuring scale 20, which may extend along the net material from one side to an opposing side of the closed loop portion 18. It will be appreciated that the length measuring scale can be oriented on the net in various ways.

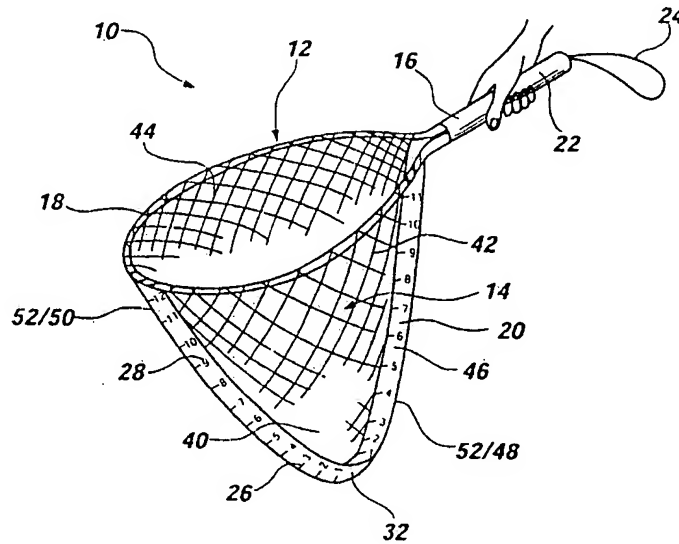


FIG. 1

In order to facilitate the rapid and easy alignment of a fish (38 in FIG. 3, reproduced below) with the measuring scale 20, the net 14 is configured to form a pocket 40 into which the fish will naturally tend to rest in substantial linear alignment with the length measuring scale. That is, the shape of the net is such as to naturally cause the fish to drop into a position aligned with the scale when a user scoops up a fish therein. If, upon initial placement of the fish in the net, the fish is not adequately aligned with the length measuring scale, the user may simply move the fish or juggle the net slightly to cause the fish to attain the desired alignment. With the net device configured in this way, a user can easily determine the size of a fish held in the net by aligning the fish with the length measuring scale, and visually comparing the fish with the length measuring scale to determine its length in the units of the scale. There is no need for the user to handle the fish in order to measure it.

The length measuring scale 20 can be disposed on the fish net 14 in various ways. In one embodiment, the length markings 26 and numerals 28 can be woven or embroidered into the fabric of the net material. Alternatively, the length markings and numerals can be applied to the surface of the net using a silk-screen or printing process.

The length markings 26 and numeral designations 28 can be configured in various ways. The length markings can represent standard units of length, such as inches, centimeters, etc. Alternatively, the scale can represent modified or non-standard units of length. For example, the length units may be larger or smaller than standard length units to compensate for curvature of a fish held in the net. When a fish 38 is held in a fish net as illustrated in FIG. 3, it will tend to rest on its side in the bottom of the net 32, in a curved position. When a fish is measured on a flat scale, its thickness may not substantially affect its apparent length. However, when curved and resting in the bottom of a net, the central axis 54 of the fish and the scale 20 are both curved, and the fish may appear to be longer than it really is.

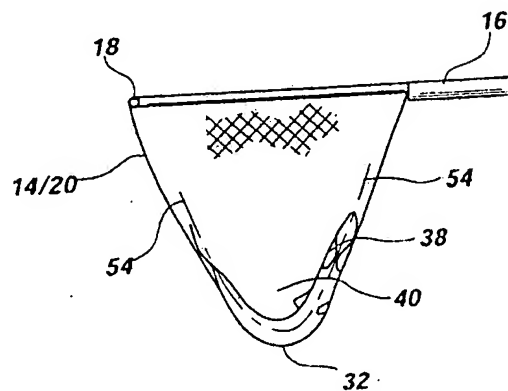


FIG. 3

To compensate for this possible curvature-related error, the distance between the length markings 26 may be modified. For example, where the scale represents inch units, the space between adjacent markings may be greater than an inch. Additionally, because the error may

depend on the thickness of the fish, longer fish may tend to introduce more error because they will generally include thicker portions. Consequently, a length measuring scale in which the units are modified in a non-linear manner may be desirable. For example, a graduated or semi-logarithmic scale may be disposed on the net 14, such that the distance between length markings gradually increases with distance from the bottom center of the net.

ISSUES

1. Whether claims 1-2, 4, 11, 18, and 22-24 (including independent claims 1 and 18) are anticipated by French Patent No. 2,582,190 to Chat (hereinafter "Chat").
2. Whether claims 5-10, 13, 14, 16-17 and 20-21 (including independent claim 14) would have been obvious to a person of ordinary skill in the art at the time of the invention over Chat in view of U.S. patent no. 5,501,026 to Bryant (hereinafter "Bryant").
3. Whether claim 12 would have been obvious to a person of ordinary skill in the art at the time of the invention over Chat in view of the Caddis online catalog reference (hereinafter "Caddis").
4. Whether the secondary considerations presented by the Appellant support allowance of the claims.
5. Whether a terminal disclaimer is required over U.S. patent no. 6,615,532 to Abel.

GROUPING OF CLAIMS

Claims 1 and 18 stand or fall together. Claims 2, 21 and 24 stand or fall together. Claims 4 and 16 stand or fall together. Claims 5 and 20 stand or fall together. Claims 7-9 stand or fall

together. Claims 10, 11 and 17 stand or fall together. Claim 12 stands on its own. Claims 6, 13 and 14 stand on their own. Claims 22 and 23 stand or fall together.

ARGUMENT

1. Chat Does Not Anticipate The Subject Matter Of Claims 1-2, 4, 11, 18 and 22-24.

In the Final Rejection, dated June 22, 2006, Claims 1-2, 4, 11, 18 and 22-24 (including independent claims 1 and 18) were rejected under 35 U.S.C. § 102(b), as being anticipated by Chat. As the Federal Circuit has stated, anticipation requires identity. See Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1321, 66 USPQ2d 1429 (Fed. Cir. 2003) (cert. denied, 540 US 982 (2003)). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. V. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The Appellant respectfully submits that Chat does not disclose each and every element of the independent claims as currently presented.

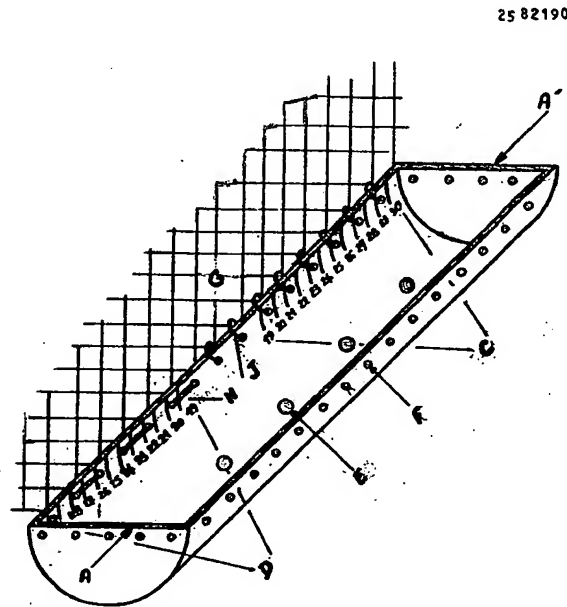
Independent claim 1 as currently presented reads as follows:

1. A fish net device, comprising:
 - a. a frame;
 - b. a net of flexible net material, attached to the frame, the frame holding the net in a position to land a fish; and
 - c. a flexible length measuring scale, permanently disposed generally linearly on a surface of the net, such that a user may determine a size of the fish held in the net by visually comparing the fish with the length measuring scale.

All of the pending independent claims (claims 1, 14 and 18) claim “a flexible length measuring scale” as in claim 1, or in the case of claim 18, the *use* of “a flexible length measuring scale.”

The Examiner has asserted that all of these limitations are met by Chat.

In the English language abstract provided for Chat, the title is translated as “Gauge for measurement of fish – comprises graduated channel with end stops and with holes for attachment to landing net.” Chat includes only one illustration, which is reproduced below:



The only portions of Chat that have been provided by the Examiner in English, other than the title, are the following abstract and a statement of “Advantage”:

A gauge is made in the shape of a gutter from moulded plastics as [sic] from metal, the cross section may be rectangular or round. At each end are placed end steps [sic] (A, A') both of which act as origins for graduations (C, D) in the respective directions along the gutter. Holes (F) around the periphery allow fixing of a thread (G) at the base of the landing net. This is assisted by a card through (H) passed [sic] the holes to ring (J) the holes forming the mesh of the net. Holes (E) in the base allow water to run out. The fish

is measured by sliding it along until the nose by [sic] butts against one end and the length can then be read from the graduations.

Advantage – No need to touch fish.

Careful reading of Appellant's independent claims 1, 14 and 18 in view of Chat reveals that Chat clearly does not include each and every element of these claims.

A. Chat Does Not Disclose a Flexible Length Measuring Scale.

As noted above, the Appellant's claims recite "a flexible length measuring scale" disposed on the net element of the claimed fish net device. Chat, in contrast, discloses a rigid gutter with length markings. This is not the same, and this point cannot be overemphasized. The relative inflexibility of the gutter is implicit in Chat because the gutter would not be able hold a fish if it were flexible to any significant extent. A flexible gutter having the configuration shown in Chat would not hold its shape when a fish is placed in it, and would therefore not allow measurement in the manner disclosed. Moreover, there is no indication in Chat that suggests that this gutter is or can be flexible, and the Examiner has pointed to none.

The Examiner's argument that Chat discloses a flexible length measuring scale is based upon the contention that the "strings/cords that hold the length measuring scale to the net" constitute flexible portions of the length measuring scale. (Final Rejection, mailed June 22, 2006, page 9). This reasoning is manifestly erroneous. First, the strings or cords that attach the gutter of Chat to the net G are not part of a length measuring scale. The scale serves the function of allowing one to measure a fish. A user of the device disclosed in Chat cannot measure a fish using the strings or cords that hold the gutter to the net material. The strings/cords simply cannot

be considered part of the scale because they cannot perform the function of a length measuring scale.

Furthermore, the characteristics of a connector do not change the characteristics of the structure to which they attach. A rigid structure can be attached to some other structure with flexible or rigid connectors, and a flexible structure can be connected with flexible or rigid connectors. The flexibility (or lack thereof) of the connectors does not alter the characteristics of the structure to which they are attached. Whether the cords or strings that attach the gutter to the net are flexible or inflexible is simply irrelevant to whether the scale is flexible or not.

B. The Length Measuring Scale of Chat is Not Disposed On the Net.

It is also significant that the connectors discussed above do not connect the length measuring scale to the net. The scale is disposed on the gutter, not on the net. It is the gutter that is attached to the net, not the scale. While rejecting the claims, the Examiner essentially admits this point: “[t]he length measuring scales . . . are disposed on the gutter . . . and the gutter is disposed on the net.” (Final Rejection, page 9). The Examiner evidently believes that the presence of intervening structure is not important: “Therefore, since the gutter frame is disposed on the net the length measuring scale is disposed on the net.” (Id).

This reasoning is faulty. The intervening structure in Chat is significant because it has different characteristics from the net, and therefore alters the functionality of the device as a whole. The Appellant’s disclosure clearly shows the length measuring scale having similar flexibility to the remainder of the net portion. Because the measuring scale of Chat is disposed on a rigid gutter rather than a flexible net, the device of Chat cannot bend and flex with a net, and therefore cannot perform the function specifically claimed for the flexible length measuring scale of the Appellant’s invention – to “determine a size of the fish held in the net by visually

comparing the fish with the length measuring scale.” (Claim 1). Instead, the measuring scale of Chat is only disclosed as being capable of allowing one to determine a size of a fish held in the gutter by “sliding [the fish] along until the nose by [sic] butts against one end” of the gutter. (Chat, Abstract). One could not determine the size of a fish that is not in the gutter because the alignment of the nose of the fish with the end stop of the gutter would be uncertain. Since the measuring scales of Chat are not disposed on a net, but instead are disposed on a rigid gutter or trough (for which there is no corresponding element in the Appellant’s claims) that is attached to a net, Chat does not teach each element of the Appellant’s independent claims.

C. Chat Does Not Disclose A Net Having A Frame.

Independent claims 1 and 14 expressly include a frame as an element of the claimed invention. Chat does not show or suggest a frame in its single illustration, and there is no mention or suggestion of a frame in any of the English language text that the Examiner has provided. The Examiner has argued that a frame element is inherent in the disclosure of Chat because “the net must be supported by a frame to be operable in landing a fish.” (Final Rejection, page 9). The Appellant submits that this assertion is erroneous.

“Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art.” Trintec Indus., Inc. v. Top USA Corp., 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002) (quoting In re Robertson, 169 F3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). Moreover, the examiner has the burden of providing evidence or scientific reasoning to support the allegation of inherency. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the prior art.” Ex parte Levy, 17

U.S.P.Q.2d 1461, 1464 (BPAI 1990) (emphasis in original) (citations omitted); see also Ex Parte Skinner, 2 U.S.P.Q.2d 1788, 1789 (BPAI 1987).

The Appellant submits that a frame is not inherent in the disclosure of Chat because a frame is not a necessary element of all fish net devices. Fish nets without a frame of any kind have been used for landing fish for centuries, both in large scale commercial fishing and in small-scale shoreline or boat-based fishing. The Examiner has pointed to no portion of Chat that teaches or suggests a frame, and none is depicted in the figure. Furthermore, without disclosing a frame and its configuration, it is impossible for Chat to satisfy the further limitation, found in independent claims 1 and 14, that the frame holds the net “in a position to land a fish.” Without actually disclosing a frame, it is impossible to determine what if any orientation a frame does or might hold the net of Chat.

The Appellant’s fish net device includes a frame of a particular configuration because it is a sport fishing net. There is no indication that the device in Chat is associated with the same type of fish net. Indeed, the illustration of Chat suggests that it is not. A gutter, like that shown in Chat, if attached to the side of a small handheld sport fishing net (which ordinarily comprises a curved net portion), would make that net very difficult or impossible to use. On the other hand, the illustration in Chat shows a portion of an apparently planar net of indefinite size and shape, to which the gutter is attached. These aspects of Chat strongly suggest that it is *not* drawn to a small handheld sport fishing net like that in Appellant’s application. Consequently, the conclusion that a frame is inherent in Chat is contrary to all appearances and teachings of that patent, and therefore without foundation in the absence of any express textual suggestion.

D. Chat Does Not Disclose Modified Units of Length or English and Metric Units.

With respect to claim 4, the Examiner has asserted that Chat teaches “modified units of length to compensate for curvature of the fish and the length measuring scale – see for example at C and D in the drawing figure.” (Final Rejection, page 3). The Appellant is at a loss to find any basis for this assertion. The length measuring scale in the figure of Chat is straight. It does not curve. While the gutter has a curved cross-section, the scale does not extend along the curve, but extends along a straight edge of the gutter.

Moreover, since the gutter of Chat is straight, there would be no curvature of a fish held in the gutter. In this context it is important to note the meaning of the term “curvature of a fish” as that term is used by the Appellant. As is clear from FIG. 3 of the application, the curvature of a fish held in the net 14 of the Appellant’s application has reference to curvature along the length of the fish, as indicated by the long axis 54. It does not relate to curvature around the girth of a fish – which is the only type of curvature that the shape of the gutter of Chat could address. The Appellant cannot find, and the Examiner has not pointed out, any portion of Chat that actually teaches or suggests compensation for curvature of a fish. Since compensation for curvature of a fish is not mentioned in Chat and the structure of that device is incapable of compensating for curvature in the manner claimed, there is thus no basis for this rejection.

Additionally, modified units of length are not apparent from the figure of Chat, nor mentioned in the text. The cited scales C and D in the figure appear to be of uniform spacing. The Examiner has asserted that “the length measuring scales – at C, D, are modified in that the measuring scales are modified to extend in different directions on the gutter.” (Final Rejection, page 9). This argument is entirely beside the point, because the direction of extension of the scales is irrelevant. The term “modified units of length,” as used in the instant patent application, has reference to the space between length markings, not the direction of the scale. The

specification states that modified units of length can include markings wherein the space between adjacent markings is greater than a standard unit of measurement, for example, or is non-linear, such as “a graduated or semi-logarithmic scale” in which the “distance between length markings gradually increases” with distance from a reference point. (Page 6, ln. 10-16). There is no teaching or suggestion in Chat to use units that are modified in any of these ways.

With respect to claims 2 and 24, Chat does not discuss the use of standard units of length, either. The drawing of Chat includes no dimension indications (e.g. standard abbreviations such as “cm” or “in.”), and the English language text that has been provided does not mention units. Since there is no mention of any kind of standard units of length, this element of the Appellant’s claims is likewise not anticipated by Chat.

F. Chat Does Not Disclose a Length Measuring Scale That is Visible on Both Sides of a Net.

With respect to claims 22 and 23, contrary to the Examiner’s assertion, Chat does not disclose a length measuring scale that is visible on both sides of a net. Viewing the figure of Chat, the length markings on the gutter are only shown along one edge of the gutter, and therefore would not be visible to a user viewing from the opposite side of the net (even assuming that the net is substantially see-through, which has not been established).

Furthermore, claims 22 and 23 include the functional limitation that the markings are visible on both sides of the net in order to allow the scale to be useful when the net is “in an inverted configuration with respect to the frame.” Since the net of Chat is depicted as being substantially planar and no frame is shown, there is no indication that it can be inverted in a manner that is applicable to a small sport fishing net. Inversion of a small sport fishing net involves pushing the net portion through the hoop portion of the frame, so that what was the

inside becomes the outside, and vice versa. Thus, having markings that are visible on both sides of the net as that term is used in the present application means that the markings can be seen on both sides of the net fabric. In Chat, since the markings are on the gutter and not the net fabric, they would not be visible on both sides of the net fabric within the meaning of the Appellant's claims.

G. The Structure of Chat Appears to Require Touching the Fish in Order to Measure it.

Finally, though Chat claims this advantage, Appellant notes that the structure of Chat does not actually appear to allow a user to measure a fish without actually touching it. The fish is measured while in the gutter, but it is not clear how the fish is to be placed in the gutter without the user touching it. The claimed advantage appears only to relate to the measurement of the fish after it is placed in the gutter – i.e. a user does not have to manually place some other device such as a measuring tape against the fish. In this way the Chat device does not perform the same function as the Appellant's device, and this lack functionality further serves to demonstrate the overall inaccuracy of the comparison that the Examiner has made.

2. The Subject Matter Of Claims 5-10, 13, 14, 16-17, 20 and 21 Would Not Have Been Obvious Over Chat In View Of Bryant.

Claims 5-10, 13, 14, 16-17, 20 and 21 were rejected under 35 U.S.C. § 103(a) as being obvious over Chat in view of Bryant. To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc., 344 F.3d 1186, 1196, 68 USPQ2d 1186 (Fed Cir. 2003).

Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

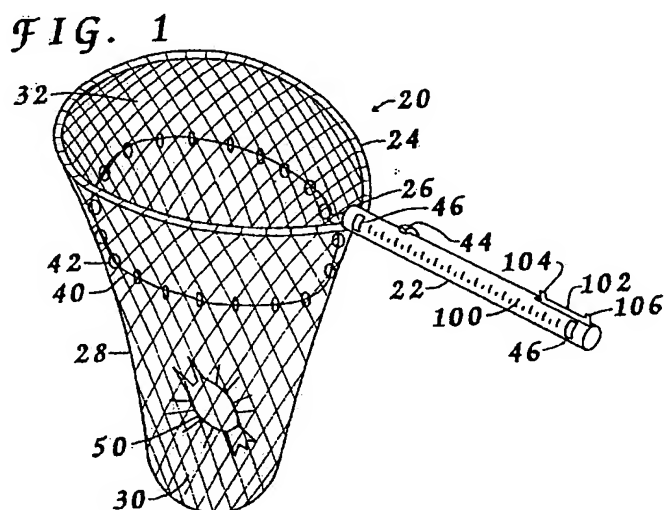
references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. ' 706.02 (j). The Appellant submits that the Examiner has not made out a prima facie case of obviousness under these authorities.

Before discussing specific claim rejections under 35 U.S.C. § 103(a), it is useful here to clarify an aspect of the claims about which there may be some confusion. The Appellant believes that the Examiner is, in many instances, comparing non-analogous portions of prior art devices as a whole with the “net” element of Appellant’s claims. In an effort to eliminate this confusion, the Appellant has previously amended the preamble of all of the claims to refer to the apparatus as a whole as a “fish net device,” so as to distinguish the claimed device as a whole from the “net” element of each claim. In other words, as clearly set out in the specification and the claims, the Appellant’s fish net device as a whole includes the distinct elements of (1) a frame and (2) a net, the “net” being only one element of the “net device” as a whole.

Many of the Examiner’s rejections are based on comparisons of non-analogous structure from the cited references. When the different elements of the Appellant’s invention are properly understood in this way and compared to the corresponding elements of the cited patents, it becomes clear that the claimed elements are simply not provided by any combination of the cited references.

A. The Combination of Bryant With Chat Does Not Provide All Elements of Any of the Claims.

As noted above, Chat does not disclose a length measuring scale that is part of a flexible net. Instead, Chat discloses length markings disposed on a rigid gutter or trough, which is a separate element from the net. Bryant does not supply this deficiency. Figure 1 of the Bryant reference is provided below. The Bryant net device 20 includes a net 28 and a frame comprising a handle 22 and hoop 24. While the device includes a measuring scale 100, this scale is not part of the flexible net element 28, but instead is part of the rigid handle 22.



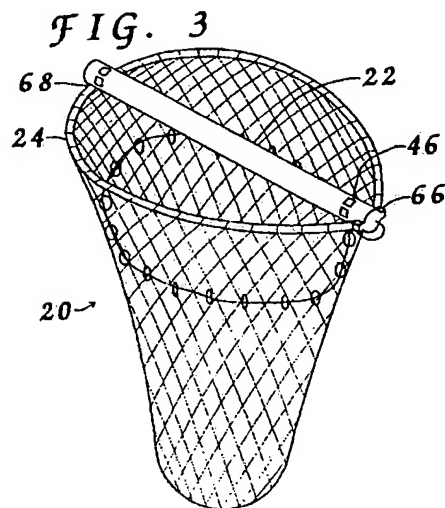
Bryant thus teaches a fish net device with a scale that is part of the net device as a whole, but not as part of the net element itself. As with Chat discussed above, the Appellant believes the Examiner is comparing non-analogous portions of prior devices as a whole with the “net” element of Appellant’s claims in order to make the claimed combination. This important difference applies to all of the claims on appeal, and cannot be overstated. Neither Chat nor Bryant teach or suggest providing a flexible length measuring scale on a flexible net portion of a fish net device having a frame. Consequently, these two patents when combined do not teach all elements of any of the Appellant’s claims.

Turning to specific claims, with respect to claims 6 and 14, the Examiner has asserted that Chat teaches a length measuring scale that “extends from one side of the net to the other,” and that Chat only lacks the teaching of a frame having a hoop shaped portion, which is taught by Bryant. This statement is inaccurate for several reasons. First, Chat does not disclose a length measuring scale extending from one side of a net to the other first because the measuring scale of Chat is not on the net at all, but is on a trough that is attached to a net, as discussed above. Second, the ends of the net in Chat are not shown. The shape and extent of the net G in the figure of Chat is entirely indefinite. No edges are shown, and thus there is no basis for any assertions about anything extending from one side to another of that net.

Furthermore, while Bryant teaches a frame with a hoop shaped portion, it does not include a length measuring scale that extends from one side of the net to the other and is also disposed on the net, as required by the independent claims. In this regard the Examiner is again comparing non-analogous portions of Bryant to the Appellant’s claims. The only possible portion of Bryant that could be argued to support this assertion is the configuration of FIG. 3 of Bryant, reproduced below. This figure shows the handle 22 of the net device folded over the hoop portion 24 of the frame. Since a length measuring scale 100 is disposed on the handle, and the handle can extend across the hoop portion of the frame, the Examiner apparently believes that Bryant shows a length measuring scale that extends from one side of the net to the other.

This reasoning is flawed because the Examiner has left out at least one of the limitations of the Appellant’s underlying independent claim. Appellant’s independent claims require that the measuring scale is flexible and is disposed on the flexible net material 14 (corresponding to element 28 in FIG. 1 of Bryant). Only with that condition satisfied is the further limitation of claim 6 (or comparable limitations in claim 14) applied, that the scale extends from one side of

the net to the other. A measuring scale on a rigid portion of the frame of the net device cannot meet this limitation.



The Examiner rejected claim 7, arguing that Chat as modified by Bryant discloses a net comprising first and second side pieces with curved edges, and a substantially linear center piece, with a length measuring scale disposed on the center piece, and the net forming a pocket into which a fish naturally tends to rest in alignment with the length measuring scale. (See Final Rejection, pages 5, 10). The Appellant believes the Examiner is again comparing non-analogous elements of the references, as discussed above. The side pieces with curved edges 24 and the supposed linear center piece 22 that the Examiner has identified in Bryant are part of the frame of the net device of Bryant, not part of the net (28).

The limitations in Appellant's claim 7, on the other hand, are directed to the net element (14 in FIG. 1) not the frame (12 in FIG. 1). With reference to FIG. 1, the flexible net portion is described in one embodiment as being assembled from "first and second side pieces 42 and 44, and a substantially linear center piece 46 . . . joined or sewn together along their edges." (Page 7, ln. 1-5). On the other hand, the net 28 of Bryant is shown as a single piece of netting, as is the

net of Chat. There is no teaching or suggestion in Chat or Bryant of a flexible net comprising two side pieces and a linear center piece that are attached together to form “an elongate pocket 40 into which a fish naturally tends to rest when scooped up into the net.” (Page 7, ln. 9-10).

Because neither Chat nor Bryant teach a net made up of multiple pieces, the additional limitations in claims 8-11 and 17 related to the materials of these pieces (e.g. different materials, same materials, and mesh and net materials of cotton and polymers) likewise are not found. As with claim 7, the Examiner’s arguments are, once again, directed to the frame 22, 24 of the net device in Bryant, not the net 28.

With respect to claim 16, the comments presented above with respect to claims 2, 4, and 24 are fully applicable here. Specifically, Chat does not teach “modified units of length,” as that term is used in the present application, for compensating for curvature along the length of a fish. Bryant does not supply this limitation. The measuring scale of the Bryant device, like that in Chat, is rigid and straight, not curved. It is not designed to be used with a fish held in a curved orientation in the bottom of the net. Consequently, the combination of Bryant and Chat does not teach the limitations of claim 16.

The Examiner has argued that the length measuring scale of Chat is curved, and consequently “the curves of the fish’s body can more evenly match up with the measuring scale when placed into the gutter frame” of Chat. (Final Rejection, page 10). This argument is erroneous. The gutter of Chat has a curved cross-section, but the measuring scale does not extend along the cross-section of the gutter. It extends along the length – along a straight side edge. Thus the only curvature of a fish to which Chat could relate would be curvature around the girth of a fish. However, measurement of the girth of a fish is not relevant to the Appellant’s claims. As discussed above, the provision of modified units of length for compensation for

curvature of a fish held in the net 14 of the Appellant's application has reference to curvature along the length of the fish, as indicated by the long axis 54 in FIG. 3. The Appellant cannot find, and the Examiner has not pointed out, any portion of Chat or Bryant that teaches or suggests compensation for curvature along the length of a fish using modified units of length, as that term is used in the application. Consequently, the combination of Bryant and Chat cannot supply this limitation.

B. There is No Motivation to Combine Bryant With Chat, Nor Any Reasonable Expectation of Success.

There is no teaching or suggestion in Bryant or Chat that would lead one of skill in the art to attach a flexible measuring scale to a flexible net attached to the hoop portion of a frame and having the other limitations of the cited claims. Accordingly, the Appellant submits that none of the claims would have been obvious in view of the cited art.

With respect to claims 5, 7, 14 and 20, there is no teaching in Chat of a net forming a pocket, or of causing a fish to rest in the bottom of a net pocket. The net G in the figure of Chat appears to be entirely flat and planar. The only portion of the device in Chat that appears designed to hold a fish is the rigid gutter that is attached to the flat net. As discussed above, the gutter is not a net, and does not have the properties of a net.

While Bryant teaches a net that does form a pocket that presumably can hold a fish, there is no suggestion to combine the elements of Chat and Bryant because the fish-holding portions of the respective devices are different. In Bryant a fish can be held in the net 28, which forms a pocket, but cannot be measured when so doing, and in Chat a fish is to be held in the gutter for measurement, but apparently not for any other purpose. Thus, the combination of the two

references cannot suggest measuring a fish while holding it in a net, though that is exactly the way in which the Examiner is interpreting it.

Moreover, a combination of Bryant and Chat would produce a sport fishing net with a rigid gutter attached to the side of the net portion, which would probably be unusable, as discussed above.

With respect to the frame limitations expressed in claims 13 and 14, there is no motivation to combine the frame of Bryant with the device of Chat because Chat does not disclose a frame at all, as discussed above. Consequently, one of skill in the art has no indication of what (if any) type of frame would be compatible with the device of Chat, and could therefore not have any reasonable expectation of success.

The absence of any motivation to combine or expectation of success also applies to the limitation of the length measuring scale extending from one side of the closed loop portion to the other, found in claims 6 and 14, discussed above. The Examiner's arguments in support of these rejections simply refer one to the figures of Bryant. The only possible portion of Bryant that could be argued to support this assertion is the configuration of FIG. 3. However, the specification of Bryant teaches that the configuration shown in FIG. 3 is intended for storage of the device, not its use. Bryant states that "FIG. 3 illustrates the utilization of a pivotal attachment 66 to place netting device 20 in a storage position." (Col. 3, ln. 27-28). In other words, the net device of Bryant is not intended to be *used* in the configuration shown in FIG. 3, but merely to be *stored* that way. In fact, the device of Bryant *cannot* be used for measuring a fish in this configuration in part because the measuring scale 100, which is disposed on the handle 22, is facing downward in this position. Thus the device of Bryant is non-functional when configured

as in FIG. 3, and therefore no combination of Bryant with Chat is suggested, and such a combination would be non-functional in any event.

3. The Subject Matter Of Claim 12 Would Not Have Been Obvious Over Chat In View Of The Caddis Reference.

The Examiner has rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Chat in view of the Caddis catalog reference (“Caddis”). Claim 12 depends from claim 1 and adds the limitation that “the length measuring scale comprises markings disposed directly on the net material, said markings being selected from the group consisting of: woven markings; embroidered markings; printed markings; and silk-screened markings.”

Provided below is an illustration of the device depicted in the Caddis catalog reference provided by the Examiner. The Appellant has been unable to obtain a high quality copy of the exact image that the Examiner provided, but believes that the image provided below, while providing a different view, depicts the same device.



The Caddis reference discloses a float tube having a stripping apron stretched across its front. There appears to be a length measuring scale printed upon this stripping apron.

Float tubes are used by fly fishermen, and the stripping apron is primarily intended for the purpose of holding a fly fisherman's line out of the water when fishing. During repeated casting of a fly rod, as is customary in fly fishing, the fisherman will repeatedly manually retract lengths of fly line with his free hand. It is frequently desired to keep this line dry. The stripping apron provides a surface for catching this retracted fishing line and holding it out of the water. The stripping apron can also be used to support a fish that is caught while the fisherman removes a hook to release the fish.

Before turning to the specific rejections of claim 12, a clarifying note is in order. The usage of the term "directly" in claim 12 should not be construed to suggest that the provision of a length measuring scale on intervening structure (the gutter) in Chat reads upon the limitations of claim 1. While the Appellant's net device is described in one embodiment as being assembled from side pieces 42 and 44 that are sewn to a substantially linear center piece 46, the length measuring scale being provided on that center piece (Page 7, ln. 1-5), the device is not limited to this embodiment. As discussed above, it is not the mere placement of the length measuring scale on intervening structure in Chat that distinguishes that device from the invention of claim 1, but that the intervening structure is inflexible, and therefore negates the claimed characteristics of the net portion of the device. The limitation in claim 12 that the length measuring scale is "directly" disposed on the net thus allows for embodiments under claim 1 in which the length measuring scale is disposed upon a separate piece of flexible material, which is then attached to the net.

A. The Combination of Caddis With Chat Does Not Provide All Elements of the Claims.

The above remarks with respect to Chat are fully applicable here, and claim 12 should be allowed as being based upon an allowable base claim for the reasons given above with respect to

claim 1. Specifically, Chat does not disclose a fish net device including a frame and a flexible net, with a flexible length measuring scale disposed on the net material, the frame holding the net “in a position to land a fish,” and the Caddis reference does not supply these deficiencies. The float tube of Caddis may include a frame (though this is not actually disclosed or necessarily apparent from the cited reference), but it is not clear that the stripping apron is attached to a frame, and in any event the stripping apron is not held in a position to land a fish. There is no frame shown in either of these references that one could employ to support a net in a position to land a fish, and the net appears to be substantially planar.

Additionally, the Examiner’s statement that Caddis discloses a length measuring scale comprising markings “selected from the group consisting of: woven markings; embroidered markings; printed markings; and silk-screened markings” is entirely without foundation. There is no mention in the Caddis reference to the particular manner in which the markings are provided on the stripping apron, and such cannot reasonably be inferred from the photograph.

B. *The Examiner has Pointed to No Motivation to Combine Caddis With Chat, and Such a Combination Would be Non-Functional.*

Additionally, the Appellant respectfully submits that there is no motivation to combine the Caddis reference with Chat. Since the stripping apron of Caddis is flat and neither intended nor suited to be used for landing a fish, one of skill in the art would not be motivated to consult the Caddis reference with respect of fish nets for landing a fish.

The Appellant notes that the Examiner’s arguments for making this combination are entirely self-referential, and do not point out any motivation contained in the cited references themselves for such a combination. In the Final Office Action, the Examiner stated that the combination of these references is proper “given the motivation to combine these references

found above in paragraph 3 of this office action.” (Final Rejection, page 11). Unfortunately, paragraph 3 of the office action does not cite any such motivation contained in the references themselves. In paragraph 3 the Examiner simply referred to the two references and concluded that “it would have been obvious to one of ordinary skill in the art to take the fish net of Chat and add the measuring scale disposed on the net from one of the methods described above of Caddis, so as to make the device more durable in that the length scale is permanently attached to the net.” (Final Rejection, page 6). This language includes no mention of why it would be obvious. Furthermore, the supposed objective of the combination “to make the device more durable in that the length scale is permanently attached to the net” (Id.) cannot support this rejection. The limitation that the length measuring scale is “permanently disposed” on the net is found in independent claim 1. It is not added by claim 12.

Finally, the supposed combination of Chat with the Caddis catalog reference would not provide the function claimed by the Appellant. The Caddis reference shows a scale apparently printed on a presumably flexible and substantially planar stripping apron attached to a float tube. The combination of Caddis with Chat apparently suggested by the Examiner is to place length markings directly on the net G of Chat. A combination of the Caddis reference and Chat in this manner would produce a substantially planar net material with length markings on it, separate from a rigid gutter that is attached to the planar net. This would be non-functional because one could not measure a fish in the gutter according to the teachings of Chat. Chat requires that a fish be placed in the gutter with its nose abutting one of the end stops. (Chat, Abstract). Additionally, even with this combination there would still be no frame that holds the net in a position to land a fish, as required by claim 1, nor would the result include structure that causes

the fish to align with the scale, or allowing a user to determine a length of a fish being held in a net.

4. The Appellant's Secondary Considerations Support Allowance.

As an additional indication to support the allowability of the claims, the Appellant previously provided an affidavit signed by the inventor attesting to the commercial success of the invention that is the subject of this patent application. A Copy of this Affidavit is included in Appendix B. This affidavit provides several years' sales figures for sport fishing nets made by Appellant that include a measuring scale integrated with the flexible net, as claimed.

The Examiner objected that this sales information is insufficient to support allowance because it does not compare Appellant's sales with sales of competitive products. The Appellant has been unable to obtain sales figures for other makers and sellers of sport fishing nets generally. However, as noted in a supplemental affidavit signed by the Appellant and provided in Appendix B, the Appellant is unaware of any other sport fishing nets, either now or in the past, that include a measuring scale integrated with the flexible net. In other words, there really are no directly competitive products. For this reason, the Appellant submits that it is not possible to compare sales of competitive products.

Because the invention is completely new, the increasing sales of the Appellant's products represent the creation of a new market, and therefore implicitly suggest a nexus between the claimed features of the invention and the increasing sales. In any event, Appellant submits that the sales of Appellant's products, taken in conjunction with the lack of directly competing products, and the arguments presented above, attests to the public acceptance and commercial success of these products, and supports a conclusion that this commercial success is a result of the novelty and non-obviousness of the invention.

5. The Appellant Has Executed A Terminal Disclaimer.

In a non-final Office Action mailed on December 20, 2005 (hereinafter “Non-Final Rejection”), the Examiner rejected claims 1-2, 4-14, 16-18, and 20-21 on the ground of nonstatutory obviousness-type double patenting over claims 1-3 and 6-18 of U.S. Patent No. 6,615,532 to Abel. The present application is a continuation of the application from which the ‘532 patent issued, and the Examiner has acknowledged that the claims presented in this application are not identical to the claims in the ‘532 patent. (Non-Final Rejection, page 2). The Appellant responded to this rejection by arguing that no terminal disclaimer is required because the patent issuing from this application, being a continuation, will automatically have the same expiration date.

In the Final Office Action, the Examiner has apparently withdrawn this rejection. However, the Appellant has determined that there is one possible situation in which a double patenting rejection could have merit in this case – to prevent possible harassment of an infringer from multiple patent holders where the ‘532 patent and a patent issuing on this application are assigned to different entities.

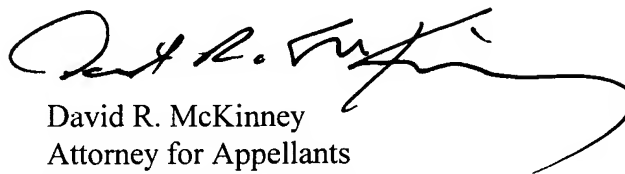
To prevent this possibility, the Appellant has executed, and provides herewith in Appendix C, a Terminal Disclaimer that includes a non-alienation provision that provides that any patent issuing on this application will be enforceable “only for and during such period that it and the ‘532 patent are commonly owned.” In view of this disclaimer, the Appellant respectfully submits that any double patenting rejection, if relevant, is now overcome.

CONCLUSION

In view of the above, the Appellant respectfully requests the Board to overturn the Examiner's rejection of claims 1-2, 4-14, 16-18 and 20-24.

DATED this 9th day of November, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David R. McKinney", with a long, sweeping horizontal line extending to the right.

David R. McKinney
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APPENDIX A: CLAIMS ON APPEAL

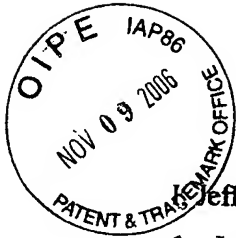
1. A fish net device, comprising:
 - d. a frame;
 - e. a net of flexible net material, attached to the frame, the frame holding the net in a position to land a fish; and
 - f. a flexible length measuring scale, permanently disposed generally linearly on a surface of the net, such that a user may determine a size of the fish held in the net by visually comparing the fish with the length measuring scale.
2. A fish net device in accordance with claim 1, wherein the length measuring scale further includes length markings, representing standard units of length, and numeral designations associated with the length markings.
3. (Canceled)
4. A fish net device in accordance with claim 1, wherein the length measuring scale includes length markings representing modified units of length to compensate for curvature of the fish and the length measuring scale.
5. A fish net device in accordance with claim 1, wherein the net forms a pocket in which the fish naturally tends to rest in substantial linear alignment with the length measuring scale.
6. A fish net device in accordance with claim 1, wherein the frame further comprises a substantially closed loop portion having opposing sides, and the length measuring scale extends from one side of the closed loop to the opposing side.
7. A fish net device in accordance with claim 6, wherein the net further comprises:
 - g. first and second side pieces with curved edges;

- h. a substantially linear center piece, having side edges, the length measuring scale being disposed on the center piece; and
 - i. the side edges of the center piece being connected to the curved edges of the first and second side pieces, forming a pocket in which the fish naturally tends to rest in substantial linear alignment with the length measuring scale.
- 8. A fish net device in accordance with claim 7, wherein the first and second side pieces and the center piece are of the same material.
- 9. A fish net device in accordance with claim 7, wherein the first and second side pieces and the center piece are of different materials.
- 10. A fish net in accordance with claim 7, wherein the center piece is of a material selected from the group consisting of: mesh and net materials of cotton and polymers.
- 11. A fish net device in accordance with claim 1, wherein the net is of a material selected from the group consisting of: mesh and net materials of cotton and polymers.
- 12. A fish net device in accordance with claim 1, wherein the length measuring scale comprises markings disposed directly on the net material, said markings being selected from the group consisting of: woven markings; embroidered markings; printed markings; and silk-screened markings.
- 13. A fish net device in accordance with claim 1, wherein the frame further comprises:
 - j. a handle; and

- k. a substantially closed loop portion, attached to the handle, the net being attached to the loop portion.
14. A fish net device, comprising:
- l. a frame having;
 - i. a handle; and
 - ii. a substantially closed loop portion, having opposite sides, attached to the handle;
 - m. a net of flexible net material, attached to the loop portion, the frame holding the net in a position to land a fish; and
 - n. a flexible length measuring scale, having length markings with numeral designations representing units of length, disposed generally linearly on the net and extending from one side of the loop portion to an opposing side thereof, the net forming a pocket into which a fish naturally tends to rest in substantial linear alignment with the measuring scale, such that a user may determine a size of the fish held in the net by visually comparing the fish with the numeral designations on the length measuring scale.
15. (Canceled)
16. A fish net device in accordance with claim 14, wherein the length measuring scale includes length markings representing modified units of length to compensate for relative curvature of the fish and the length measuring scale.
17. A fish net device in accordance with claim 14, wherein the net is of a material selected from the group consisting of: mesh and net materials of cotton and polymers.
18. A method of measuring a size of a fish, comprising the steps of:

- o. placing a fish within a fish net device having a frame and a net of flexible net material, and a flexible length measuring scale disposed on the net material;
 - p. aligning the fish with respect to the length measuring scale; and
 - q. visually comparing the fish to the length measuring scale, so as to determine a size of the fish.
19. (Canceled)
20. A method in accordance with claim 18, wherein the step of placing the fish within the fish net device further comprises causing the fish to rest in a bottom of the net in substantial linear alignment with the length scale.
21. A fish net device in accordance with claim 14, wherein the length markings represent standard units of length.
22. A fish net device in accordance with claim 1, wherein the length measuring scale is visible on opposing sides of the net, such that the net may be used in an inverted configuration with respect to the frame.
23. A fish net device in accordance with claim 2, wherein the length measuring scale and the numeral designations are visible on opposing sides of the net, and are configured to be properly readable when the net is in an inverted configuration with respect to the frame.
24. A fish net device in accordance with claim 2, wherein the standard units of length are selected from the group consisting of English units and metric units.

APPENDIX B



AFFIDAVIT OF JEFFREY T. ABEL

Jeffrey T. Abel, declare as follows:

1. I am over eighteen years of age and have personal knowledge of the facts stated herein.
2. I am a resident of Victor, Montana.
3. I am the inventor of an invention entitled FISH NET WITH LENGTH MEASURING SCALE as claimed in United States patent application serial no. 10/616,460 (the '460 application), filed on July 8, 2003.
4. I am the President of JTA Products, Inc., a Montana Corporation, which has been making and selling sport fishing nets and replacement fish net bags that incorporate a length measuring scale as claimed in the '460 application, for the past several years under the trademark MEASURE NET.
5. JTA Products has had great commercial success with its MEASURE NET products, as evidenced by our continually increasing sales. Specifically, our sales in units for the years 2003-2005 are as shown in the following table:

	Complete Nets	Net Bag Only
<u>Year</u>	<u>No. Sold</u>	<u>No. Sold</u>
2003	2,210	N/A
2004	11,262	716
2005	12,807	1,861

6. I expect that sales will continue to rise as our MEASURE NET products become better known.
7. Buyers and users of our MEASURE NET products have been extremely enthusiastic about the products and the improvement that they provide over what has been available previously. I have received numerous unsolicited comments from customers expressing their joy at having this new product, and how easy it makes measuring a fish that they have caught.

DATED this 18 day of April, 2006.


Jeffrey T. Abel

SUPPLEMENTAL AFFIDAVIT OF JEFFREY T. ABEL

I, Jeffrey T. Abel, declare as follows:

1. I am over eighteen years of age and have personal knowledge of the facts stated herein.
2. I am a resident of Victor, Montana.
3. I am the inventor of an invention entitled FISH NET WITH LENGTH MEASURING SCALE as claimed in United States patent application serial no. 10/616,460 (the '460 application), filed on July 8, 2003.
4. I am the President of JTA Products, Inc., a Montana Corporation, which has been making and selling sport fishing nets and other sport fishing equipment for many years.
5. I have been making and selling a sport fishing net product that includes the features outlined in the '460 application under the trademark MEASURE NET.
6. Other than my own MEASURE NET product, I am not aware of a single sport fishing net product that has ever been developed or that is now or has ever been on the market that incorporates a length measuring scale into the flexible net portion of a sport fishing net.
7. I believe that there are no products on the market that are directly competitive with my MEASURE NET product.

DATED this 9 day of November, 2006.

Jeffrey T. Abel
Jeffrey T. Abel AKA JEFF ABEL

JURAT

State of MONTANA
County of RAVALLI

Subscribed and sworn/affirmed to before me this 9th day of NOVEMBER

in 2006, by JEFFREY T ABEL aka JEFF ABEL

Linda K. Glover
Notary Public

My Commission Expires: 06/01/2008



LINDA K. GLOVER
NOTARY PUBLIC-MONTANA
Residing at Darby, Montana
My Comm. Expires _____



LINDA K. GLOVER
NOTARY PUBLIC-MONTANA
Residing at Darby, Montana
My Comm. Expires 06/01/2008